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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,079	07/24/2001	Todd R. Collart	IA 1510.01 US	3412
22887	7590	06/25/2004	EXAMINER	
DISCOVISION ASSOCIATES INTELLECTUAL PROPERTY DEVELOPMENT 2355 MAIN STREET, SUITE 200 IRVINE, CA 92614			MCQUELLAN, JAMES S	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/912,079	COLLART, TODD R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James S McClellan	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 May 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### *Amendment*

1. Applicant's submittal of an amendment was entered on May 26, 2004, wherein:
  - claims 1-14 are pending and
  - claim 1 has been amended.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,035,329 (Mages et al.) in view of U.S. Patent No. 6,608,804 (Shim).

Regarding **claim 1**, Mages et al. discloses a method for tracking usage of a recording medium comprising: receiving a first indicia (see column 2, lines 46-51) corresponding to an identifier of the recording medium upon the recording medium being input into a device by a user; receiving a second indicia identifying the device (see column 4 lines 4-19); determining a characteristic of the recording medium based on the first indicia (see column 3, lines 27-31); identifying the client device based upon the second indicia (it is inherent that the client device has an identification number because the client device is in communication with a service provider over the Internet); and storing the characteristic of the recording medium and the

identity of the device in a database (see column 3, lines 45-55); **[claim 2]** the characteristic of the recording medium includes an intended usage (see column 3, lines 27-31, requiring or not requiring pay-per-view); **[claim 3]** the characteristic of the recording medium includes whether the recording medium was intended for rental (pay-per-view) or retail sale (not pay-per-view); **[claim 4]** utilizing the client device to read the identifier (see column 4, lines 4-19); and transmitting indicia corresponding to the identifier from the client device to a server via the Internet utilizing a browser embodied on the client device (see column 3, lines 45-55); **[claim 5]** determining a manner in which the recording medium is being used by the client device based on the determined client identity and recording medium characteristic (see column 3, lines 27-31; requiring or not requiring pay-per-view); and **[claim 14]** the determined characteristic of the recording medium is that the recording medium has been stolen, the method further comprising the step of disallowing play of the recording medium based upon the determination that the recording medium has been stolen (see column 4, lines 33-41).

Mages et al. fails to disclose storing information in a burst cut area.

Shim discloses a burst cutting area code including a unique disk code including the type of a disk (see column 3, lines 47-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al. with information stored in a BCA as taught by Shim, because storing information in a BCA allows the identification information to be stored in the innermost area of the lead-in area on the disk, whereby providing a consistent and easy access location for the system identifying the disk.

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4. Claims 6, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of Shim as set forth above for claims 1-5, and 14 and further in view of U.S. Patent No. 4,658,093 (Hellman).

Regarding **claims 6, 12, and 13**, Mages et al. and Shim fail to explicitly disclose the step of monitoring a database to determine whether a recording medium is being operated on multiple devices; allowing play only an identified client device; and monitoring the number of times the recording medium has played and disallowing play of the recording medium after the recording medium has been played a predetermined number of times.

Hellman teaches the steps of monitoring a database to determine whether a recording medium is being operated on multiple devices; allowing play only an identified client device (see Abstract, lines 11-14, “base unit specific”); and monitoring the number of times the recording medium has played and disallowing play of the recording medium after the recording medium has been played a predetermined number of times (see column 4, lines 21-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al./Shim with the recording medium monitoring features taught by Hellman, because monitoring the use of a recording medium helps reduce software piracy (see Hellman, Abstract).

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of Shim as set forth above for claims 1-5, and 14 and further in view of U.S. Patent No. 6,332,126 (Peirce et al.).

Regarding **claims 7-9**, Mages et al. and Shim fail to explicitly disclose identifying the merchant from whom the user obtained the recording medium and transmitting marketing information.

Peirce et al. teaches the use of disclose identifying the merchant from whom the user obtained the recording medium and transmitting marketing information (see column 2, lines 15-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al./Shim with merchant monitoring of Peirce et al., because monitoring merchant information increases the data associated with the user's purchasing history and will improve marketing for potential merchants.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. in view of Shim as set forth above for claims 1-5, and 14 and further in view of U.S. Patent No. 6,260,758 (Blumberg).

Regarding **claims 10 and 11**, Mages et al. and Shim fail to explicitly disclose affinity programs that include issuing random prizes and offering coupons.

Blumberg teaches the use of affinity programs that include issuing random prizes and offering coupons (see paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mages et al./Shim with the affinity programs taught by Blumberg, because affinity programs increase the customers loyalty to the merchant.

***Response to Arguments***

7. Applicant's arguments filed May 26, 2004 have been fully considered but they are not persuasive.

All arguments are moot in view of the new grounds of rejection necessitated by Applicant's amendment.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

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*James S. McClellan*  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
June 21, 2004